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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,465	06/29/2001	Dominique Gougeon	10015737-1	5281

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EXAMINER

NALVEN, ANDREW L

ART UNIT	PAPER NUMBER
	2134

DATE MAILED: 12/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/893,465	GOUGEON ET AL.
	Examiner	Art Unit
	Andrew L Nalven	2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 29 June 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-7 and 9-20 is/are rejected.
- 7) Claim(s) 8 and 19 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 29 June 2001 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

1. Claims 1-20 are pending.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4, 6, 11, and 13-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Sudia US Patent No. 5,659,616. Sudia discloses a method for securely using digital signatures in a commercial cryptographic system.

4. With regards to claims, 1, 11, 13, Sudia teaches a smartcard having stored thereon a private key (Sudia, column 9 lines 53-54, private key), a file signing tool arranged to receive a file to be signed (Sudia, column 10 lines 2-5), to access the smartcard (Sudia, column 9 lines 51-55), and to download signed files to the terminal (Sudia, column 9 lines 47-55, sign document and apply certificate), wherein the smartcard includes an embedded secure processor programmed to perform all digital signing operations that require access to the private key (Sudia, column 16 line 64 – column 17 line 11).

5. With regards to claims 2, 14, Sudia teaches the smartcard having stored thereon a signer certificate containing a public key corresponding to the private key (Sudia, column 17 lines 17-25, device certificate, Figure 13 Item 1301).

6. With regards to claims 3, 15, Sudia teaches the signer tool being arranged to retrieve the signer certificate from the smartcard and append the signer certificate to the signed file for use by the terminal in authenticating the digital signature generated by the smart card and file signing tool (Sudia, Figure 7 Item 700, column 9 lines 51-55, authorization certificate).

7. With regards to claim 4, 16, Sudia teaches the signer certificate including fields designating file types that may be authenticated by the signer certificate (Sudia, column 10 lines 50-64).

8. With regards to claims 6 and 17, Sudia teaches the smartcard storing a PIN wherein the smartcard is arranged to perform digital signing operations only if a corresponding PIN is input through the file signing tool (Sudia, column 9 lines 14-18, PIN).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 5 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sudia US Patent No. 5,659,616 in view of Veil et al US Patent No. 6,092,202.

11. With regards to claims 5 and 17, Sudia fails to teach an owner certificate installed on the terminal for use by the terminal in authenticating the signer certificate. Veil teaches an owner certificate installed on the terminal for use by the terminal in authenticating the signer certificate (Veil, column 13 lines 30-41). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to utilize Veil's method of storing certificates for use in authenticating with Sudia's secure digital signature system because it offers the advantage of decreases the amount of time needed for certification verification (Veil, column 13 lines 38-41).

12. Claims 7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sudia US Patent No. 5,659,616 in view of Kenneth Weiss "When A Password Is Not A Password."

13. With regards to claims 7 and 10, Sudia everything described above, but fails to teach an authentication level indicating a number of pins to enter in order to access. Weiss teaches a smartcard where high security warrants the entering of a number of PINs in order to access the smartcard (Weiss, page 107 column 2 "Challenge-Response" PIN and challenge code). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to utilize Weiss' method of inputting multiple PINs with Sudia's secure digital signature system because it offers the advantage of providing conclusive proof that the user is in possession of something

secret and possesses the smartcard thus providing secure access (Weiss, page 107 column 2 "Challenge-Response" PIN and challenge code).

14. Claims 9 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sudia US Patent No. 5,659,616 and Kenneth Weiss "When A Password Is Not A Password" as applied to claim 7 above, and further in view of Deo et al US Patent No. 5,721,781.

15. With regards to claims 9 and 20, Sudia as modified above fails to teach different PINs permitted access to different private keys and public key certificates having different file type properties thereby enabling different authorization levels to be established. Deo teaches multiple PINs each being permitting access to a different application on a smart card (Deo column 5 lines 57-65, unique identifications to each application as a special password) and each application on a smart card having its own certificate thereby providing different authorization levels (Deo, column 5 lines 62-65, column 10 lines 31-55). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to utilize Deo's method of permitting access to different certificates using different PINs with Sudia as modified because it offers the advantage of allowing different applications to each have different certificates, public keys, and private keys attached to them thus allowing a single card to provide multiple services (Deo, column 2 lines 26-40).

Allowable Subject Matter

16. Claims 8 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

17. The following is a statement of reasons for the indication of allowable subject matter:

18. Claims 8 and 19 define the distinct feature of combining PINs to form a combined PIN to be compared with a PIN stored on the smartcard before digital signing operations are performed. The closest prior art, Sudia, Deo, and Weiss teach the use of single PINs or multiple PINs, but fail to teach the combining of PINs for use in comparing against a stored PIN and thus the cited prior art fails to anticipate or render the above limitation obvious.

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

20. Taylor US Patent No. 5,578,808 discloses a data card that can be used for transactions involving separate card issuers.

21. Smithies et al US Patent No. 6,091,835 discloses a method for transcribing electronic affirmations.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew L Nalven whose telephone number is 571 272

3839. The examiner can normally be reached on Monday - Thursday 8-6, Alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on 571 272 3838. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Andrew Nalven



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